TRANSCRIPT OF RECORD

Supreme Court of the United States

OCTOBER TERM, 1952

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No. 46

HUGH W. SANFORD, PETITIONER,

vs.

ROBERT C. KEPNER

ON WRIT OF CERTIORARI TO THE UNITED STATES COURT OF APPEALS
FOR THE THIRD CIRCUIT

PETITION FOR CERTIORARI FILED MAY 2, 1952

CERTIORARI GRANTED JUNE 9, 1952

SUPREME COURT OF THE UNITED STATES

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INDEX

	Original	Print
Record from U.S.D.C. for the Middle District of Pennsylvania	1	1
Amended complaint	2	1
Opinion, Follmer, J.	7	6
Proceedings in U.S.C.A. for the Third Circuit	17	16
Opinion, Hastie, J.	17	16
Judgment	24	22
Order allowing certiorari	25	23
Stipulation as to contents of record	26	23

JUDD & DETWEILER (INC.), PRINTERS, WASHINGTON, D. C., AUG. 11, 1952.

[fol. 1]

IN THE UNITED STATES DISTRICT COURT FOR THE MIDDLE DISTRICT OF PENNSYLVANIA

HUGH W. SANFORD, Plaintiff-Appellant,

vs

ROBERT C. KEPNER, Defendant

[fol. 2] AMENDED COMPLAINT

Amended Complaint To Authorize Issuance Of Patent And For Declaratory Judgment

(1) Plaintiff, Hugh W. Sanford, is a citizen of the United States and a resident of Knoxville, in the County of Knox, in the State of Tennessee.

(2) Defendant, Robert C. Kepner, upon information and belief, is a resident of Bloomsburg, in the County of Columbia, in the State of Pennsylvania.

(3) This complaint is filed under the Patent Laws of the United States, Section 4915 of the Revised Statutes, as amended, (U. S. Code, Title 35, Section 63), and under the Declaratory Judgments Act (U. S. Code, Title 28, Sections 2201 and 2202), and under U. S. Code, Title 28, Section 41.

(4) On January 3, 1945, the said Hugh W. Sanford, being the original, first and sole inventor of improvements in Latch Tripping Mechanism, duly filed in the United States Patent Office an application for Letters Patent of the United States on said invention, Serial No. 571,170, which application complied in all respects with the requirements of the law in such cases made and provided, and with the Rules of Practice of the United States Patent Office.

(5) On August 4, 1943, the defendant, Robert C. Kepner, alleging to be the inventor of certain improvements in Dump Car Control, filed an application for Letters Patent of the United States, Serial No. 497,286, the legal title to which application has been and was vested in the defendant, according to the records of the United States Patent Office, on March 17, 1949.

(6) On October 22, 1946, the Commissioner of Patents declared an interference, No. 82,623, between the aforesaid

application of Hugh W. Sanford, Serial No. 571,170, and the aforesaid application of Robert C. Kepner, Serial No. 497,286, the issue of which interference comprised the following counts:

Count 1. In conveying mechanism, the combination with a trackway, a dumping conveyance movable along the trackway and including a lading body with a drop bottom door, and latch means for holding the door closed and movable to release the door for opening, of [fol. 3] tripping mechanism including means for actuating the latch to release the door, and separate means laterally spaced from said release means and substantially in the same upright transverse plane as said release means and actuated by bearing engagement with the under portion of the vehicle moving over the tripping mechanism for controlling the release means.

Count 2. In conveying mechanism, the combination with a trackway, a dumping conveyance mounted on the trackway and including a lading body with a drop bottom door and latch means for holding the door in closed position and movable to release the door for opening, said latch means being located wholly above the lowest portion of the lading body in the same longitudinal vertical plane of the conveyance, of tripping mechanism mounted at the trackway and including an engaging member mounted for upward movement relative to the trackway in position for engaging the latch means during movement of the conveyance over the tripping mechanism to release said door, yieldable means normally tending to hold said engaging member in an elevated position, and a contact member substantially fixed relative to the releasing member and movable therewith in position to be raised and lowered by engagement with the under surface of the conveyance during movement thereover.

(7) Thereafter, on June 27, 1947, the aforesaid interference, No. 82,623, was re-declared to add the following additional counts thereto:

Count 3. In conveying mechanism, the combination with a trackway, a dumping conveyance movable along

the trackway and including a lading body with a drop bottom door, and latch means for holding the door closed and movable to release the door for opening, of tripping mechanism mounted at the trackway and including latch release means in position to engage the latch means during movement of the conveyance over the tripping mechanism to release the door for opening, [fol. 4] and means fixed relative to the latch release means and located at substantially the same elevation as said latch release means when said latch release means is in latch engaging position, and said means being in position for engagement by the under surface of the conveyance during movement thereof over the tripping mechanism for controlling the releasing position of the latch release means.

Count 4. In conveying mechanism, the combination with a trackway, a dumping conveyance movable along the trackway and including a lading body with a drop bottom door, and latch means for holding the door closed and movable to release the door for opening, of tripping mechanism mounted at the trackway and including an engaging member mounted for upward movement to a position for engagement by the latch means during movement of the conveyance over the tripping mechanism, a contact member fixed relative to said engaging member and extending to substantially the same elevation to be guided along the under surface of the conveyance to depress the engaging member beneath the conveyance, and yielding means normally tending to hold said engaging member in a raised position relative to the trackway.

(8) Testimony was taken on behalf of both parties in said interference, No. 82,623, and the plaintiff, Hugh W. Sanford, duly furnished proof establishing his priority in said interference and complied in all respects with the provisions of the law and the Rules of Practice of the United States Patent Office governing interference proceedings.

(9) Upon the final hearing of said interference, No. 82,623, the Board of Interference Examiners awarded priority of invention of the subject matter in issue therein to the said Robert C. Kepner, the defendant.

(10) No appeal has been taken by the plaintiff in said interference to the United States Court of Customs and Patent Appeals to review the decision of the Board of Interference Examiners therein.

[fol. 5] (11) Consequently, the Commissioner of Patents has refused, and still refuses, to grant Letters Patent of the United States to the plaintiff upon the aforesaid application of the said Hugh W. Sanford for the inventions embraced in the claims heretofore set forth as the counts of said interference, although the said Hugh W. Sanford is lawfully entitled thereto.

(12) The defendant, Robert C. Kepner, has heretofore and still is claiming in the aforesaid interference, No. 82,623 and in his application, Serial No. 497,286, as aforesaid, that he is entitled to a patent for the subject matter of the claims involved in said interference, as aforesaid, notwithstanding that said claims are unpatentable to the defendant in his said application for the following reasons:

(a) That said claims do not read on the disclosure in the aforesaid Kepner application, Serial No. 497,286.

(b) That the said claims are unpatentable to the defendant in view of the following prior patents and prior inventions:

No. 423,500	Townsend	Mar. 18, 1890
No. 430,546	Sharp	June 17, 1890
No. 530,939	Fox	Dec. 18, 1894
No. 601,203	Truax	Mar. 22, 1898
No. 628,876	Wall	July 11, 1899
No. 775,778	Neilson	Nov. 22, 1904
No. 894,204	Hogan	July 28, 1908
No. 936,443	Gibson	Oct. 12, 1909
No. 995,316	Baubert	June 13, 1911
No. 1,146,081	Labit	July 13, 1915
No. 1,195,975	Carmichael	Aug. 29, 1916
No. 1,370,472	Miller	Mar. 1, 1921
No. 1,378,574	Weston	May 17, 1921
No. 1,388,388	Swank	Aug. 23, 1921
No. 1,753,163	Spelling	Apr. 1, 1930
No. 1,876,637	Dietrichson	Sept. 13, 1932
No. 2,225,462	Rose	Dec. 17, 1940
No. 2,225,463	Rose	Dec. 17, 1940

[fol. 6] No.	2,399,708	Sanford	May 7, 1946
German No.	61,803	Meyer	Sept. 2, 1891
French 1st Addition to No.	19,989 / 469,275	Renauld	Oct. 5, 1915
Austria No.	112,784	Nussbaum	Nov. 15, 1928

and possibly others not now known to the plaintiff, and notice of which will be given the defendants as soon as learned by the plaintiff, and of which proof will be offered at the trial.

(c) That the said claims are unpatentable to the defendant, because of public knowledge and use by the Pruden Coal and Coke Company, Pruden, Tennessee, of a device embodying the subject matter of the aforesaid claims prior to the date of invention alleged by the defendant, Robert C. Kepner, and more than a year prior to the date of his application, Serial No. 497,286, filed August 4, 1943.

(d) That the said claims are unpatentable to the defendant because the subject matter thereof was on sale and sold by the Sanford-Day Iron Works, Inc., Knoxville, Tennessee, more than a year prior to the amendment of said Kepner application to include the subject matter of said claims.

Wherefore, the defendant, Robert C. Kepner, is not entitled to the grant of a patent for said claims in his application, according to Section 4886 of the Revised Statutes (U. S. Code, Title 35, Section 31).

Wherefore, the plaintiff, having no other adequate relief save by this Honorable Court, respectfully prays:

1. That this Court adjudge that the plaintiff, Hugh W. Sanford, is entitled, according to law, to receive Letters Patent of the United States for the aforesaid invention and as specified in the claims herein set forth as the counts of the aforesaid interference, No. 82,623, and as contained in his application, Serial No. 571,170.

[fol. 7] 2. That the Court adjudge that the plaintiff, Hugh W. Sanford, was the first, true and original inventor of the said improvements in Latch Tripping Mechanism, as set forth in his application, Serial No. 571,170 and defined in

the counts of interference No. 82,623, and is entitled to receive Letters Patent of the United States for the aforesaid invention and the subject matter of the aforesaid claims.

3. That the defendant, Robert C. Kepner, is not entitled to receive Letters Patent of the United States for the subject matter of the aforesaid claims, and that the claims are unpatentable to said Kepner.

4. That the plaintiff be awarded the costs of this proceeding, and for such relief as in equity may seem just.

IN UNITED STATES DISTRICT COURT

OPINION—July 9, 1951

This action is the outgrowth of an interference proceeding in the Patent Office, No. 82,623, declared by the Commissioner of Patents between the party Sanford and the party Kepner to determine which of them was the prior inventor of certain patentable subject matter common to their respective applications for patent, namely, Kepner Application Serial No. 497,286, filed August 4, 1943, and Sanford Application Serial No. 571,170, filed January 3, 1945. Consequently, upon the decision of the Board of Interference Examiners of the Patent Office in Interference No. 82,623, awarding priority of invention of the subject matter in issue to Kepner, Patent No. 2,487,447 was granted to him as provided in R.S. 4904, 35 U.S.C. § 52.

The complaint was filed under Section 4915 of the Revised Statutes, 35 U.S.C. § 63, and seeks a review of the action of the Patent Office in Interference No. 82,623, as aforesaid, and the issues raised are priority and patentability.

At the outset of the trial the Court indicated that it would hear the complete case, both as to priority and patentability, and if it became necessary in the determination of priority, the Court would consider the prior art so far as necessary for that purpose; that in the event the primary issue of priority would be determined adversely to the plaintiff, no consideration would then be given to the validity of the [fol. 8] defendant's patent, since a 4915 action is not intended to test the validity of a patent. In other words

the Court took its position with the line of cases that holds that in a 4915 action patentability need not be considered where the claimed priority is not established, and, by the same token, when the one seeking the decree under 35 U.S.C. § 63 prevails in the trial court upon the question of priority, the patentability of his claim must be decided.[1] With that concept in mind, after a full and complete trial, and on consideration of the evidence, oral arguments and briefs of counsel, I find it unnecessary herein to consider the question of patentability. The basic required formula to be followed in the attempted solution of a controversy such as we have here is that propounded in Morgan v. Daniels, 153 U. S. 120, at 125, as follows:

> "Upon principle and authority, therefore, it must be laid down as a rule that where the question decided in the Patent Office is one between contesting parties as to priority of invention, the decision there made must be accepted as controlling upon that question of fact in any subsequent suit between the same parties, unless the contrary is established by testimony which in character and amount carries thorough conviction. * * *"

The parties to this action and to the above mentioned interference proceeding in the Patent Office are the same and the issue herein, to wit, priority of invention of the subject matter involved in the said interference, is likewise the same as there decided.

Plaintiff as the junior party had the burden of proof in the Patent Office proceeding; as the complainant here he has the burden of meeting the requirements of the Morgan v. Daniels, supra, formula. Walker on Patents (Deller's Edition) Vol. 2, Pages 971-972, states:

> "The burden is on the complainant to prove the truth of his bill, by evidence that is clear and conclusive * * *. [fol. 9] Such an action has the characteristics of a proceeding to set aside a judgment and as such, is not to be sustained by a mere preponderance of evidence. * * *"

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[1] Cleveland Trust Co. v. Berry et al., (6 Cir.) 99 F. 2d 517; Heston et al. v. Kuhlke et al., (6 Cir.) 179 F. 2d 222.

The general subject matter of the patent applications disclosing the invention in controversy is a device for unlocking the door supporting-latch of a mine car of the drop bottom type to allow the door to open for the discharge of lading. Specifically, the device consists of a tripping mechanism which is positioned in the trackway and is provided with a latch releasing member or element which is constantly pressed upwardly by a spring to an elevated position above the trackway so as to project into the path of the door latch as the car moves over the track for dumping and thus release the door latch by coming in contact therewith as the car passes along the track.

The claims, directed to the invention common to the interfering applications, are stated in the four counts of Interference No. 82,623, Sanford v. Kepner, and are as follows:

"Count 1 In conveying mechanism, the combination with a trackway, a dumping conveyance movable along the trackway and including a lading body with a drop bottom door, and latch means for holding the door closed and movable to release the door for opening, of tripping mechanism including means for actuating the latch to release the door, and separate means laterally spaced from said release means and substantially in the same upright transverse plane as said release means and actuated by bearing engagement with the under portion of the vehicle moving over the tripping mechanism for controlling the release means.

"Count 2 In conveying mechanism, the combination with a trackway, a dumping conveyance mounted on the trackway and including a lading body with a drop bottom door and latch means for holding the door in closed position and movable to release the door for opening, said latch means being located wholly above the lowest portion of the lading body in the same longi- [fol. 10] tudinal vertical plane of the conveyance, of tripping mechanism mounted at the trackway and including an engaging member mounted for upward movement relative to the trackway in position for engaging the latch means during movement of the conveyance over the tripping mechanism to release said

door, yieldable means normally tending to hold said engaging member in an elevated position, and a contact member substantially fixed relative to the releasing member and movable therewith in position to be raised and lowered by engagement with the under surface of the conveyance during movement thereover.

"Count 3 In conveying mechanism, the combination with a trackway, a dumping conveyance movable along the trackway and including a lading body with a drop bottom door, and latch means for holding the door closed and movable to release the door for opening, of tripping mechanism mounted at the trackway and including latch release means in position to engage the latch means during movement of the conveyance over the tripping mechanism to release the door for opening, and means fixed relative to the latch release means and located at substantially the same elevation as said latch release means when said latch release means is in latch engaging position, and said means being in position for engagement by the under surface of the conveyance during movement thereof over the tripping mechanism for controlling the releasing position of the latch release means.

"Count 4 In conveying mechanism, the combination with a trackway, a dumping conveyance movable along the trackway and including a lading body with a drop bottom door, and latch means for holding the door closed and movable to release the door for opening, of tripping mechanism mounted at the trackway and including an engageing (sic) member mounted for upward movement to a position for engagement by the latch means during movement of the conveyance over the tripping mechanism, a contact member fixed relative to said engaging member and extending to substantially the same elevation to be guided along the [fol. 11] under surface of the conveyance to depress the engaging member beneath the conveyance, and yielding means normally tending to hold said engaging member in a raised position relative to the trackway."

Plaintiff contends that the counts of the interference involve the track, the conveyance, the latch at the back and the tripping device, all as one combination; and that the patent involves the entire structure of the protected latch car. Defendant, on the other hand, takes the position that the issue here is solely, "who was the prior inventor of the invention for latch tripping mechanism disclosed in the Sanford application No. 571,170 and the Kepner application No. 497,286 for releasing the latch of the protected latch car."

Plaintiff argues, "The defendant must show that he was the first to invent every element in the claim or the complete combination of elements before he is entitled to an award of priority." If this contention is sound, no valid claim for an improvement applicable to an old apparatus or device could ever be granted. As a matter of fact, the Sanford Application Serial No. 571,170, herein involved, states that the invention there disclosed is "for the improvement in Latch Tripping Mechanism set forth in the annexed specification;" furtherfore, in the specifications, at Page 1, it specifically states that "This invention relates to improvements in Latch Tripping Mechanism, particularly for mine cars and other conveyors having drop-bottom doors for discharge of the lading therefrom."

The drafting of the claims here involved followed the customary pattern employed when the new invention is an improvement of a particular part or portion of an old device; the claims reciting the features of the new invention and, in combination therewith, such features of the old apparatus or device as are necessary to point out the relation of the improvement to the parts of the old apparatus with which the improvement co-operates; it is in this manner that the functional purposes of the alleged improvement are made manifest. This matter was fully covered by the Supreme Court in Williams Manufacturing Co. v. United [fol. 12] Shoe Machinery Corp., 316 U. S. 364, at Page 369, as follows:

> "* * * In describing the novel combinations embodied in the claims, it was necessary to make reference to certain portions of the machine in connection with which the new combinations were to operate and with

which they were to dovetail, but, in mentioning these other mechanical parts, the claim does not purport to embody them as elements of the claimed combination. To construe such a claim for a combination of new elements intended to be embodied in some well recognized mechanical aggregation, such as a sewing machine or a washing machine, as a claim covering all the mechanical details, or all the well known parts of the machine, would be to nullify every patent for an improvement in a type of machine long in use and would invalidate thousands of patents for improvements in standard machines. It would be difficult to describe an improvement in a washing machine without naming such a machine as the thing to which the patent is addressed, and equally difficult to refrain from referring to various parts of the machine, such as the tub or the motor which actuates the washer. But it has never been thought that a claim limited to an improvement in some element of the machine is, by such reference, rendered bad as claiming a monopoly of tubs or motors used in washing machines."

Plaintiff further contends that the testimony of Dendler, and of the defendant Kepner himself, justified the inference that Dendler and not Kepner invented certain features so far as they are incorporated in the dump car unlatching mechanism which is here in controversy. This contention is completely inappropriate, for as stated in Luellen v. Claussen et al., 43 App. D. C. 444,

"The question for determination in the present case is which of the parties thereto is entitled to the award of priority, and the question whether a third party may subsequently defeat the successful party here is beside the issue and may not be raised."

[fol. 13] Also, as the Court of Customs and Patent Appeals in Cooper v. Hubbell, 53 F. 2d 1072, at Page 1076, stated:

"* * * Appellant would not be entitled to an award of priority as against appellee even if the proof established that the invention was in fact made by other persons. Foster v. Antisdel, 14 App. D. C. 552. The issue

in an interference proceeding is not whether a senior party may be entitled to priority as against all persons, but the question is whether the junior applicant has sustained the burden of establishing his own priority over that of his opponent. Beidler v. Caps & Leininger, 36 F. (2d) 122, 17 C.C.P.A. 703."

The issue here is a very narrow one, namely, the priority between the junior party, Sanford, and the senior party, Kepner, of the invention of a certain latch tripping mechanism for releasing the latch of a protected latch car. We are not concerned with any other portion of the structure to which this functional device becomes a part, nor are we concerned with the prior inventive activities of any third party alien to these proceedings. What testimony then has plaintiff offered in his effort to overrule the otherwise controlling Patent Office decision as to priority of invention, and did the proffered testimony in character and amount carry thorough conviction? To attain this objective the plaintiff endeavors to overturn the finding of the Board of Interference Examiners that the latch tripping mechanism allegedly installed and tested at the rock bin of the Pruden Coal Company mine in 1942 was "nothing more than an abandoned experiment", and that "commercial use or success of the device is not necessary in order to constitute a reduction to practice but it must appear that the inventor himself is satisfied as to the practicability of the device for its intended purpose. It is quite obvious from a reading of the record that Sanford did not consider his device as practical at the time of the test at Pruden."

I am not only in complete accord with this conclusion but find it confirmed in Sanford's oath to his application No. [fol. 14] 571,700, (sic) filed January 3, 1945, in which apparently to meet the statutory requirement of a lawfully filed application for patent, he swore that he did not believe that the invention described and claimed therein was "in public use or on sale in the United States for more than one year prior to this application."

The opinion of the Board of Interference Examiners stated, inter alia:

"The device which was removed from the Pruden Coal Company has become lost and could not be found

on diligent search, however, a device was constructed during the taking of testimony allegedly like that used at the Pruden Company and introduced in evidence as Sanford Exhibit 29. Tests were run on the reconstructed device to show its mode of operation. Obviously these tests cannot be relied upon as a *nunc pro tunc* reduction to practice."[2]

Concerning the Pruden test in 1942, the plaintiff submitted, for the consideration of the Court, depositions of Robert E. Jones and the party Sanford; and the testimony of Roy E. Linville, Howard A. Page, D. E. Griffith, and Edward R. Hughes.

The evidence of Jones and Sanford is definitely opinion evidence, and both in their depositions of January 7, 1948, which are a part of the record of the Patent Office proceeding, admitted that they had never seen the device installed at Pruden in operation. Sanford's deposition of April 4, 1950, again admits that he had not seen the device in use at Pruden after its installation there in 1942, nor indeed had he seen the reinstallation at Pruden in 1948.

The testimony of Roy E. Linville, both in the Patent Office proceeding and in the instant proceeding, is completely lacking in any suggestion that he ever saw the device [fol. 15] in operation at Pruden as allegedly installed for testing in 1942.

The new testimony of Howard A. Page concerning the construction and operation of the alleged device at Pruden in 1942 is not convincing. While he stated that he helped to install the device at Pruden in 1942, he had nothing to

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[2] This same device, which was built in 1948, was reinstalled in 1950. Considerable testimony was introduced tending to show its inefficiency and also a substantial variance in the materials used in its construction from that of the 1942 device of which it was supposed to be a duplicate. I have not felt it necessary to consider either the inefficiency of the reinstallation or the variance of materials used, neither of which received consideration in the opinion of the Board of Interference Examiners and are not essential elements to the conclusions reached by the Board.

do with its operation. His testimony was given from memory and was to a degree hearsay.

D. E. Griffith appeared to be the only witness produced by Sanford who saw the device in operation at Pruden in 1942, and his testimony adds nothing of a substantial nature to his testimony given in the Patent Office proceeding.

The remaining witness was the expert, Edward R. Hughes, who admitted that he had never seen the device alleged to have been installed at Pruden in 1942. His testimony is, therefore, a completely theoretical opinion, and obviously is a direct attack on the patentability of the Kepner patent. A great portion of his testimony was devoted to a consideration of the prior art and its relation to the applications for patent here involved. None of this testimony could be considered as having any relevancy to the question of priority, which, as we have previously indicated, is our first and primary concern. This witness also testified at considerable length as to the readability and interpretation of the claims in suit. Evaluating this portion of the testimony in a light most favorable to the plaintiff, it certainly did not in my opinion qualify as being sufficiently impressive to overcome the decision of the Patent Office.

In Solomon v. Renstrom (8 Cir.) 150 F. 2d 805, the court, citing Morgan v. Daniels, supra, stated (Page 808):

> "* * * The interpretation of the claims of a patent is not to be determined by the opinion of experts, but is a question of law for the court. * * * The additional evidence was therefore simply advisory. The court was not required to accept it even though it may have stood without contradiction. * * *"

[fol. 16] and on Page 809:

> "In the final analysis, this case presents a situation in which the only testimony introduced at the trial that had not been introduced and considered by the Court of Customs and Patent Appeals was in the nature of opinions of expert witnesses. As already observed, the trial court was not bound to credit this character of testimony, and it affirmatively appears that the court

rejected it. It can not therefore be said that a conclusion contrary to that adopted by the Court of Customs and Patent Appeals was established 'by testimony which in character and amount carries thorough conviction.' "

See also Smith et al. v. Carter Carburetor Corporation (3 Cir.) 130 F. 2d 555. As the court stated in the Smith case, "where all of the tribunals which pass upon a question of priority in an interference proceeding in the Patent Office reach the same conclusion with respect thereto, a court will not overrule that conclusion unless error therein appears very clearly."

The plaintiff has completely failed to sustain his burden of establishing "by testimony which in character and amount carries thorough conviction", that the decision of the Board of Interference Examiners is incorrect.

This Opinion contains a statement of the essential facts and of the law applicable thereto in conformity with Rule 52 of the Federal Rules of Civil Procedure, 28 U.S.C. The complaint must be dismissed.

July 9, 1951.

(S) Frederick V. Follmer, United States District Judge.

[fol. 17] IN UNITED STATES COURT OF APPEALS FOR THE THIRD CIRCUIT

No. 10,562

HUGH W. SANFORD, Appellant,

v.

ROBERT C. KEPNER

Appeal from the United States District Court for the Middle District of Pennsylvania

Argued January 11, 1952

Before Goodrich and Hastie, Circuit Judges and Burns, District Judge

OPINION OF THE COURT—Filed March 24, 1952

By HASTIE, Circuit Judge:

This litigation began in Patent Office interference proceedings where Sanford and Kepner were the opposing applicants. At that stage the Board of Interference Examiners awarded priority of invention to Kepner who thereupon received a patent covering the counts of interference. Sanford then brought a bill in equity in the district court pursuant to Section 4915 of the Revised Statutes (1875), *as amended*, 35 U. S. C. § 63 (1946 ed.), which provides:

[fol. 18] "Whenever a patent on application is refused by the Board of Appeals or whenever any applicant is dissatisfied with the decision of the board of interference examiners, the applicant . . . may have remedy by bill in equity . . . and the court, having cognizance thereof . . . may adjudge that such applicant is entitled, according to law, to receive a patent for his invention, as specified in his claim or for any part thereof, as the facts in the case may appear. And such adjudication, if it be in favor of the right of the applicant, shall authorize the commissioner to issue such a patent on the applicant filing in the Patent Office a copy of the adjudication and otherwise complying with the requirements of law . . ."

In the district court, the suit was dismissed on the ground that Sanford had failed to sustain the burden imposed by *Morgan v. Daniels*, 1894, 153 U. S. 120, 125, of establishing "by testimony which in character and amount carries thorough conviction" that the decision of the Board of Interference Examiners was incorrect. This appeal contests that finding, and also, the refusal of the district judge to pass upon the issue of patentability of the alleged invention. These points will be taken up separately.

I

The general subject matter of the interfering patent applications is a device for tripping the door supporting latches on mine cars of the drop bottom type to permit discharge of the contents of the car. Kepner's application, for "Dump car Control", was filed on August 4, 1943; Sanford's for "Latch Tripping Mechanism", not until January 3, 1945. In the interference proceedings, therefore, it was incumbent on Sanford, as the junior party, to prove his priority of invention by a preponderance of evidence. This he sought to do by establishing an actual reduction to practice at the rock bin of the Pruden Coal & Coke Company in [fol. 19] Tennessee the year before Kepner by filing application with the Patent Office, had obtained a constructive reduction to practice. The testimonial evidence before the Board of Interference Examiners, however, though subject to conflicting inferences, affords adequate basis for its conclusion that the mechanism tested out at the Pruden Company proved impracticable for its intended purpose, was discarded by the Company in favor of a similar device of demonstrated utility, and was abandoned by its inventor in favor of different lines of development, until after the Kepner application had been filed.

In the district court, Sanford was confronted with a more rigorous burden of proof: *Morgan v. Daniels, supra; S. & S. Corrugated Paper Machinery Co. v. George W. Swift, Inc.*, 3 Cir. 1949, 176 F. 2d 358, 360. This he sought to surmount by additional testimony from six witnesses, four of whom had previously testified at the interference proceedings. Their credibility, insofar as affected by demeanor, was, of course, peculiarly within the province of the trier of fact.

But beyond this, only one of the witnesses, the president of the coal company, had anything to do with the operation of the Pruden device and his testimony at the trial added nothing to what he already had said at the interference proceedings. The remaining testimony, moreover, was opinion in part, hearsay in part, and, in part, equivocal. The district court was not persuaded by this additional testimony. We think it did not substantially change the overall picture presented at the interference proceedings. And with reference to that picture, in the language of the *Morgan* case, "It is enough to say that the testimony as a whole is not of a character or sufficient to produce a clear conviction that the Patent Office made a mistake in awarding priority of invention to the defendant". 153 U. S. at 129. In these circumstances the conclusion reached by the district court should and will be sustained.

[fol. 20] Issue is also taken with the holding of the district court that the dispute over priority related to the invention of "a certain latch tripping mechanism for releasing the latch of a protected latch car." Sanford asserts that the invention covered by the counts is "a combination *of* a trackway, a dumping conveyance, a door, a latch *and* tripping mechanism" (italics added); and that he is admittedly the prior inventor of the combination so defined. But the short answer to this contention is that the language of the counts does not lend itself to this construction. Count one is illustrative of all: "*In* conveying mechanism [general class of apparatus], the combination *with* a trackway, a dumping conveyance . . . [etc.; details of old structure], *of* tripping mechanism including . . . [details of improvement]" (italics added). Such reference in a patent claim to the structural setting within which a particular invention has been designed to operate is proper and familiar, but does not enlarge the invention. See *Williams Mfg. Co. v. United Shoe Machinery Corp.*, 1942, 316 U. S. 364, 380.

II

Appellant further contends that the patent issued to Kepner upon termination of the interference proceeding is void for lack of invention because disclosed by prior art. As warranting adjudication of this issue he invokes both

the Declaratory Judgment Act, 28 U. S. C. § 2201 (1946 ed.) and Section 4915 of the Revised Statutes. But some manifest threat to the interests or interference with the activities of the petitioner beyond the issuance of a patent to another is required to create a controversy justiciable under the Declaratory Judgment Act between him whom the patent may injure and the patentee. *Treemond Co. v. Schering Corp.*, 3 Cir. 1941, 122 F. 2d 702, 705; followed in *Federal Telephone & Radio Corp. v. Associated Telephone & Telegraph Co.*, 3 Cir. 1948, 169 F. 2d 1012, *cert. den.*, 335 U. S. 859; Borchard, Declaratory Judgments, 1941 ed., 807. Here there is no claim that Kepner has done any-
[fol. 21] thing menacing to Sanford beyond the acquisition of letters patent. Hence, the Declaratory Judgment Act supplies no basis for relief beyond what Section 4915 may provide. The substantial question is whether, in a Section 4915 proceeding, a court, having decided that a claimant does not have priority of invention, should also pass upon the issue of patentability.

That question is not raised here for the first time. This court has held that where priority of invention is decided against the plaintiff in a proceeding under Section 4915, the patentability of defendant's invention should not be adjudicated. *Smith* v. *Carter Carburetor Corp.*, 1942, 130 F. 2d 555; *S. & S. Corrugated Paper Machinery Co., Inc. v. George W. Swift, Jr., Inc., supra*, (by implication). Such a judgment, merely dismissing the claim of priority, does not "impute any validity to the defendant's patent or approval of the claims thereof as drafted". 130 F. 2d at 560. Were it not for a persisting split of authority in the circuits and a certain measure of ambiguity engendered by what has recently been said by the Supreme Court in *Hoover Co.* v. *Coe*, 1945, 325 U. S. 79, at 89-90, we would be content to have the matter rest upon our earlier decision.

While no other circuit has held that in these circumstances the issue of patentability should not be decided, the Court of Appeals for the Sixth Circuit has held such decision unnecessary, when the issue is raised, as here, by the plaintiff who has failed to establish priority of invention; *Heston v. Kuhlke*, 1950, 179 F. 2d 222; *Cleveland Trust Co. v. Berry*, 1938, 99 F. 2d 517; *cf., Christie v. Seybold*, 1893, 55 F. 69. And, in special circumstances, the Court of Ap-

peals for the Eighth Circuit has found such decision uncalled for even in connection with an award of priority to the plaintiff. *Ericson v. Jorgensen*, 1950, 180 F. 2d 180, *cert. den.*, 340 U. S. 813.

In the Seventh and District of Columbia Circuits, on the other hand, the Courts of Appeals have declared unequivocally that patentability of the invention disclosed is the first [fol. 22] issue that should be decided by the court in a Section 4915 suit between parties to a prior interference proceeding. *Minneapolis Honeywell Reg. Co. v. Milwaukee Gas Sp. Co.*, E. D. Wis. 1948, 78 F. Supp. 569, *aff'd.* 7 Cir. 1949, 174 F. 2d 203; *Knutson v. Gallsworthy*, D. C. Cir., 1947, 164 F. 2d 497. Both courts cite as controlling authority the case of *Hill v. Wooster*, 1890, 132 U. S. 693, the significant language from which therefore bears quotation:

> "The provision of section 4915 is that the Circuit Court may adjudge that the applicant 'is entitled, according to law, to receive a patent for his invention, as specified in his claim, or for any part thereof, as the facts in the case may appear; and that, if the adjudication is in favor of the right of the applicant, it shall authorize the Commissioner to issue the patent. It necessarily follows that no adjudication can be made in favor of the applicant, unless the alleged invention for which a patent is sought is a patentable invention . . . A determination of that issue [priority of invention] alone, in favor of the applicant, carrying with it, as it does, authority to the Commissioner to issue a patent to him for the claims in interference, would necessarily give the sanction of the court to the patentability of the invention involved". *Id.*, at 698.

Priority of invention in that suit, however, in contradistinction to this, had been determined in favor of the applicant-plaintiff. And the necessity of passing upon patentability was there predicated upon the scheme of Section 4915 which has made an adjudication of priority in favor of the applicant a sufficient basis for issuance of a patent to him. But nothing in Section 4915 or *Hill v. Wooster* can be taken as requiring a district court to incorporate in a judgment dismissing applicant's claim of priority of inven-

tion an adjudication as to the defendant's entitlement to letters patent.

[fol. 23] Appellant further relies, as did the court in *Knutson v. Gallsworthy, supra,* on what was said in text and supporting footnote by the Supreme Court in *Hoover Co. v. Coe,* 1945, 325 U. S. 79, by way of distinguishing and explaining its earlier opinion in *Hill v. Wooster:*

> " . . . [T]his court held [in *Hill v. Wooster*] that if it appeared that neither application disclosed invention (a matter which should have moved the Commissioner not to declare an interference) the bill should be dismissed.[29]

We think the foregoing language suggests at most a privilege, certainly not a duty, of the district court to pass upon patentability at the instance of an unsuccessful claimant of priority of invention.

The judgment will be affirmed.

A true Copy:
Teste:

—— —— Clerk of the United States Court of Appeals for the Third Circuit.

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[29] "Section 16 of the Act of 1836 . . . expressly provided that upon a bill filed as a result of Patent Office decision on an interference the court might adjudge either of the patents void in whole or in part. This language was evidently omitted in later acts as surplusage, for obviously if either patent was void for lack of invention, or other cause, the question of interference disappeared." 325 U. S. at 89-90.

[fol. 24] IN UNITED STATES COURT OF APPEALS FOR THE THIRD CIRCUIT

No. 10,562

HUGH W. SANFORD, Appellant,

vs.

ROBERT C. KEPNER

On Appeal from the United States District Court for the Middle District of Pennsylvania

Present: Goodrich and Hastie, Circuit Judges, and Burns, District Judge

JUDGMENT—March 24, 1952

This cause came on to be heard on the record from the United States District Court for the Middle District of Pennsylvania and was argued by counsel.

On consideration whereof, it is now here ordered and adjudged by this Court that the judgment of the said District Court in this case be, and the same is hereby affirmed, with costs.

Attest:

Ida O. Creskoff, Clerk.

(File endorsement omitted.)

[fol. 25] SUPREME COURT OF THE UNITED STATES, OCTOBER TERM, 1951

No. 746

HUGH W. SANFORD, Petitioner,

vs.

ROBERT C. KEPNER

ORDER ALLOWING CERTIORARI—Filed June 9, 1952

The petition herein for a writ of certiorari to the United States Court of Appeals for the Third Circuit is granted. The case is transferred to the summary docket.

And it is further ordered that the duly certified copy of the transcript of the proceedings below which accompanied the petition shall be treated as though filed in response to such writ.

[fol. 26] IN THE SUPREME COURT OF THE UNITED STATES

STIPULATION AS TO CONTENTS OF RECORD—Filed July 30, 1952

It is hereby stipulated and agreed by and between Counsel for the Petitioner and Respondent, subject to the approval of the Court, that the following items constitute all of the essential parts of the record necessary for consideration by the Court of the question involved in the appeal:

1. The Amended Complaint.
2. The Decision of the District Court.
3. The Appeal to the Court of Appeals.
4. The Decision of the Court of Appeals.

J. Preston Swecker, Attorney for Petitioner. Wilmer Mechlin, Attorney for Respondent.

(File endorsement omitted.)